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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,431	08/29/2001	Taisei Matsumoto	NIT-297	7065

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MATTINGLY, STANGER & MALUR  
Suite 370  
1800 Diagonal Road  
Alexandria, VA 22301

EXAMINER

REILLY, SEAN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/940,431

Applicant(s)

MATSUMOTO, TAISEI

Examiner

Sean Reilly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is a first action on the merits of this application. Claims 1-21 amended on 8/29/2001 are presented for further examination.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 4/24/2001. It is noted, however, that applicant has not filed a certified copy of the Japan 2001-126367 application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 3, 4, 6-15, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. In considering claims 3 and 4, each recite the limitation "the first and second unopened time limits" in line 2. There is insufficient antecedent basis for this limitation in the claims. Additionally the use of "and/or" in line 3 of each claim is ambiguous.
3. In considering claim 6, the claim recites the limitation "the contents of notification" in line 2. There is insufficient antecedent basis for this limitation in the claim. Additionally claim 6 recites the statement "the contents of notification are made to differ." This statement is ambiguous; it fails to distinctly describe what constitutes a difference in the notification content.

4. In considering claim 7, the claim is incomprehensible as written. The claim must be rewritten using proper grammar that conforms to current U.S. practice.
5. In considering claim 8, the claim recites the limitation "the user" in line 3. There is insufficient antecedent basis for the limitation in the claim. Additionally the statement "wherein charging is performed...in accordance with the results," is ambiguous.
6. In considering claim 9, the claim recites the limitation "the user" in line 2. There is insufficient antecedent basis for this limitation in the claim.
7. In considering claim 10, the claim recites the limitation "the information of the unopened time limit" in line 2. There is insufficient antecedent basis for this limitation in the claim.
8. In considering claim 11, the claim recites the limitation "the contents of modifications" in line 2. There is insufficient antecedent basis for this limitation in the claim.
9. In considering claim 12, the claim recites the limitation "the effect" in line 2. There is insufficient antecedent basis for this limitation in the claim.
10. In considering claim 13, the claim recites the limitation "the information" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim. Additionally the statements, "the information is announced" and "are posted" in lines 3 and 6 respectively, are ambiguous. As a whole the claim is not clear as written. The claim must be rewritten using proper grammar that conforms to current U.S. practice.
11. In considering claim 14, the claim recites the limitation "the user" in line 2. There is insufficient antecedent basis for this limitation in the claim. Additionally the statement "the number of setting items," is ambiguous.

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12. In considering claim 15, the claim is incomprehensible as written. The claim must be rewritten using proper grammar that conforms to current U.S. practice.

13. In considering claim 18, the claim recites the limitations "the recipient" and "the sender" in lines 3 and 5 respectively. There is insufficient antecedent basis for this limitation in the claim.

14. In considering claim 19, the claim recites the limitation "unopened information" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (U.S. Paten No. 6,442,589; hereinafter "Takahashi").

In considering claims 17 and 21, Takahashi discloses an electronic mail management system that manages unopened electronic mail, comprising:

- ❑ an electronic mail sending (Col 6, line 25) and receiving unit (Col 5, line 41),
  - ❑ an unopened notification condition master (Col 6, line 2), and
  - ❑ a notification instruction unit (Col 6, line 24),
- wherein
- ❑ the unopened notification condition master sets a plurality (Col 6, line 4) of unopened time limits (Col 6, lines 39-43), unopened information notification

destinations (Col 3, line 42), and notification methods in accordance with a combination of the mail address of the electronic mail recipient and the mail address of the electronic mail sending source (Col 6, line 36), [A filter, which sorts messages based on the sender address inherently sorts messages based on the recipient address since an electronic mail is sorted based on a filter for that specific recipient. ]

- and the notification instruction unit posts the unopened information using the notification method set in the notification destination that is set in the unopened notification condition master when unopened electronic mail exists even if the unopened time limit set in the unopened notification condition master elapses (Col 6, line 24).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 3-5, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S. Patent No. 6,442,589; hereinafter "Takahashi"), in view of Shaffer et al. (U.S. Patent 5,995,594; hereinafter "Shaffer").

In considering claims 1 and 16, Takahashi discloses an electronic mail management method wherein the electronic mail management system posts the presence of unopened

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electronic mail to a set notification destination by a preset communication means (Col 3, lines 25-34 and 40-43) in combination with an unopened time limit (Col 6, lines 39-43). However, Takahashi does not disclose posting the presence of unopened electronic mail every time the unopened time limit at which received mail is kept unopened elapses. Nonetheless, the feature of continuously alerting a user to an unopened mail after each time limit elapses is well known, as evidenced by Shaffer.

In a similar art, Shaffer discloses a message notification system, which posts the presence of unopened messages repeatedly after each time limit elapses until the message is opened (Col 2, lines 40-49). While the Shaffer disclosure primarily focuses on voice messages, Shaffer discloses that the invention can “be used in any other type of multimedia messaging system (e.g., facsimile, e-mail...and /or any other type of message via any available media)” (Col 3, lines 1-4). Shaffer further discloses that the invention benefits users by providing a method for notifying users of messages located in their mailboxes (Col 2, 63-65). Thus, given the teaching of Shaffer, it would have been obvious to a person having ordinary skill in the art to design the Takahashi system to post the presence of unopened electronic mail every time the unopened time limit at which received mail is kept unopened elapses.

In considering claim 3, Takahashi discloses the electronic mail management method according to claim 1, wherein the first and second *notification destinations* are set in accordance with a combination of mail addresses of the recipient and the sender. In Takahashi's system the filters used to sort messages to notification destinations may sort messages based on the sender address (Col 6, line 35). Further, since an electronic mail is addressed to a recipient and sorted based on a filter for that recipient, a filter, which sorts messages based on the sender address

inherently sorts messages based on the recipient address. Additionally Takahashi discloses that a plurality of filters may be used (Col 3, line 31) to sort and forward messages to a variety of *notification destinations* (Col 3, line 41).

In further considering claim 3 *time limits*, Takahashi discloses the use of several combinations and varieties of filters for sorting messages (Col 6, lines 1 –67) including a given time interval (time limit) for unopened messages (Col 6, line 41). Given the teachings of Shaffer and inclusion of those teachings in Takahashi's system as stated above, it would have been obvious to further expand Takahashi's time interval (time limit) filter to include the option of selecting multiple time limits. Therefore Takahashi in view of Shaffer teaches the electronic mail management method according to claim 1, wherein the first and second *time limits* are set in accordance with a combination of mail addresses of the recipient and the sender.

In considering claim 4, as discussed above the Takahashi system in view of Shaffer has the ability to set the first and second unopened time limits and/or notification destinations through a filter or combination of filters. Takahashi also discloses that such a filter may sort based on a keyword (Col 6, line 44). Thus, Takahashi in view of Shaffer discloses the electronic mail management method according to claim 1 wherein the first and second unopened time limits and/or notification destinations are set in accordance with a keyword contained in a title of the electronic mail.

In considering claim 5, Takahashi discloses the electronic mail management method according to claim 1, wherein information about a time zone where the notification can be performed to the recipient or sender of electronic mail or the time zone where an unopened state is not to be calculated (Col 6, lines 62-65).

In considering claim 19, Takahashi discloses the electronic mail management system according to claim 17, wherein a time zone in which the notification of unopened information is made or not made, or an unopened state is to be calculated or not to be calculated can be set in the unopened notification condition master (Col 6, lines 62-65).

In considering claim 20, as discussed above the Takahashi system in view of Shaffer has the ability to set unopened time limits and/or notification destinations (methods) through a filter or combination of filters. Takahashi also discloses that such a filter may sort based on a keyword (Col 6, line 44). Thus, Takahashi discloses the electronic mail management system according to claim 17, wherein the setting of a keyword contained in the title of received mail and the setting of the unopened time limit, notification destination and notification method combined with the keyword can be set in the unopened notification condition master.

17. Examiner takes Official Notice (see MPEP § 2144.03) that charging a fee for services rendered based on the “results” of a notification or the “communication charges” associated with a notification was well known in the art at the time the invention was made.

18. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Shaffer as applied to claim 1 above, and further in view of the Official Notice stated above.

In considering claims 8 and 9, Takahashi in view of Shaffer fails to teach charging a fee to a user in accordance with the results or communication charges to which an unopened notification is performed. However, as referenced in the above Official Notice, the act of charging a fee for services rendered based on the results of a notification or the communication

charges associated with a notification is well known. Therefore, it would have been obvious for a person having ordinary skill in the art to incorporate charging a fee for services rendered based on the results and/or communication charges associated with an unopened electronic mail notification into the method disclosed by Takahashi in view of Shaffer above.

19. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S. Patent No. 6,442,589; hereinafter "Takahashi"), in view of Hidemasa (Japan Patent Publication No. 07-183912).

The paragraph number references cited from Hidemasa below, reference the detailed description paragraph numbers starting with 1 through 24 as generated by the JPO English translation engine.

In considering claim 2, Takahashi discloses an electronic mail management method, comprising the step of posting the presence of unopened electronic mail to a recipient of the unopened electronic mail by a preset means (Col 3, lines 25-34 and 40-43) when the unopened electronic mail exists exceeding a preset first unopened time limit (Col 6, lines 41-43).

However, Takahashi fails to teach posting a similar notification to the *sender* of the electronic mail. Nonetheless, the feature of posting the presence of the unopened electronic mail to the *sender* of the electronic mail by a preset means when the unopened electronic mail exists exceeding an unopened time limit is well known, as evidenced by Hidemasa. In a similar art, Hidemasa discloses an electronic mail management method where the sender of an electronic mail is notified of an unread message after a preset time limit (Paragraph 23). Hidemasa further discloses that such a sender notification method allows the "effectiveness" of an email to be

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acquired by the sender (Paragraph 6). Thus, given the teaching of Hidemasa, it would have been obvious to a person having ordinary skill in the art to design the Takahashi system to alert the sender of an electronic mail when that mail exceeds an unopened time limit, in order to notify the sender when an email is not read by a recipient in a given time period. Additionally the time limits for notifications to the recipient or sender are selected and set by a user. Therefore any order or combination of time limits can exist including a first time limit for recipient notification and a second time limit greater than the first time limit for sender notification.

In considering claim 18, Takahashi in view of Hidemasa discloses the electronic mail management system according to claim 17, wherein an unopened time limit (Takahashi Col 6, lines 41-43) at which the notification destination is the recipient (Takahashi Col 3, lines 25-34 and 40-43) and another unopened time limit at which the notification destination is the sender (Hidemasa Paragraph 23) are set in the unopened notification condition master (Takahashi Col 6, line 2). Additionally the time limits for notifications to the recipient or sender are selected and set by a user. Therefore any order or combination of time limits can exist including a first time limit for recipient notification and a second time limit greater than the first time limit for sender notification.

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Shaffer as applied to claim 1 above, and further in view of Hidemasa.

In considering claim 6, Takahashi in view of Shaffer teaches that the content of an unopened electronic mail notification to the *recipient* will simply include the content of the electronic mail to be forwarded (Takahashi Col 3, line 47). However, Takahashi in view of

Shaffer fails to teach the content of an unopened electronic mail notification to the *sender*. In a similar art, Hidemasa discloses an electronic mail management method where the *sender* of an electronic mail is notified of an unopened message after a preset time limit (Paragraph 23).

Additionally Hidemasa discloses the unopened electronic mail notification includes content, which notifies the sender about the unopened electronic mail (Paragraph 9, last sentence).

Hidemasa further discloses that such a sender notification method allows the “effectiveness” of an email to be acquired by the sender (Paragraph 6). Given the teaching of Hidemasa, it would have been obvious to a person having ordinary skill in the art to design the Takahashi in view of Shaffer method to include content, in an unopened electronic mail notification to the sender, which notifies the sender that the sent mail is unopened. Thus, Takahashi in view of Shaffer as applied to claim 1 above, and further in view of Hidemasa discloses the contents of a mail notification management method according to claim 1, wherein the contents of notification are made to differ according to whether the notification destination of unopened information is the recipient or sender.

21. Claims 10-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

In considering claim 10, the prior art of record teaches

- ❑ setting a combination of a sending source mail address, a receiving mail address, and an unopened time limit in an unopened notification condition master;
- ❑ posting to a sender of electronic mail by a preset means that the electronic mail sent is unopened when the electronic mail sent from the sending source mail

address set in the unopened notification condition master to the receiving mail address is unopened exceeding the unopened time limit.

However, the prior art of record fails to teach an electronic mail method wherein

- an electronic mail sending source can refer to the information of the unopened time limit that is set to be posted to the sending source by specifying the sending source mail address set in the unopened notification condition master.

The prior art of record specifically teaches notifying the sender an electronic mail that remains unopened after a given period of time. However, for each sent mail the sender must select an unopened time limit for the particular mail being sent. In the disclosed invention an unopened time limit is stored for each sender in the notification condition master. When an email is sent the condition master is able to reference an unopened time limit for the sent email based on the sender mail address. Thus, this limitation in claim 10, "an electronic mail sending source can refer to the information of the unopened time limit that is set to be posted to the sending source by specifying the sending source mail address set in the unopened notification condition master," does overcome the art of record.

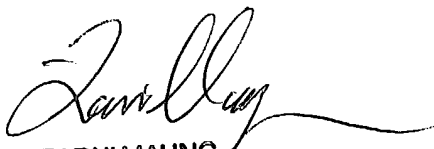
22. The prior art made of record, in the enclosed PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record discloses several more message notification systems where either the recipient or sender is notified of a message via various means.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 703-308-8646. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SR  
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ZARNI MAUNG  
PRIMARY EXAMINER